

**Application Serial No. 10/584,782
Attorney Docket No. 10191/4611
Reply to Office Action of April 13, 2009**

Remarks

I. Introduction

With the addition of new claims 28 to 32, claims 14 to 32 are pending in the present application, since claims 1 to 13 were previously canceled. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper, and cited references.

II. Objection to Drawings

The Office Action objects to the drawings under 37 CFR 1.21(d) for not being descriptive enough. Figures 1 to 4 have been amended to include descriptive legends as suggested by the Examiner, thereby rendering moot the present objection. Withdrawal of the objection is therefore respectfully requested.

III. Rejection of 14 to 22 and 24 to 27 Under 35 U.S.C. § 102(e)

Claims 14 to 22 and 24 to 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,628,233 (“the Knockeart reference”).

In regards to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As to further regards of the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from

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the teachings of the applied art.” M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

With respect to claim 14, the Office Action asserts that the Knockeart reference, at column 38, lines 6 to 9, discloses a method where a permanent portion is transmitted from the intermediate server to the device through a first transmission path and is stored in the device. The cited section discusses transferring data over a data connection to an in-vehicle system. The Office Action further asserts that a discussion in the Knockeart reference regarding **static data** discloses the presence of “a permanent portion.” However, the Knockeart reference does not disclose that the data transferred over the data connection, as discussed at column 38, lines 6 to 9, is the static data. Rather, column 38 specifically refers to the data being “update data.” *See* the Knockeart reference, col. 38, line 11. Therefore, the Knockeart reference does not disclose, or even suggest, that the permanent portion is transmitted and stored on the device from the intermediate server through a first transmission path.

To further facilitate matters, claim 14 has been amended herein without prejudice to provide that *a user inputs a request to transmit the permanent portion and the system identifies the intermediate server that is located in the vicinity of the device*. Claim 14 has also been amended to provide for *checking the central server to ascertain if the device is authorized to access the temporary portion*. The Knockeart reference does not disclose, or even suggest, these features.

For the foregoing reasons, the Knockeart reference does not disclose, or even suggest, all of the features of claim 14, so that the Knockeart reference does not anticipate claim 14 or any of its dependent claims, e.g., claims 15 to 22 and 24 to 27.

Withdrawal of this anticipation rejection of claims 14 to 22 and 24 to 27 is therefore respectfully requested.

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IV. Rejection of Claim 23 Under 35 U.S.C. § 103(a)

Claim 23 was rejected under 35 U.S.C. § 103(a), as being unpatentable over the Knockeart reference in view of U.S. Patent No. 4,340,935 (“the Anlauf reference”).

To reject a claim as obvious under 35 U.S.C. § 103, the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied.

First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396.

Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Office Action does satisfy these requirements as to all of the features of the claims.

Claim 23 depends from claim 14, and is therefore also allowable for at least the same reason as claim 14, since the Anlauf reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Knockeart reference.

Withdrawal of this obviousness rejection of claim 23 is therefore respectfully requested.

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V. New Claims

New claims 28 to 32 do not add any new matter and are supported by the present application, including specification, as originally filed. Claim 28 depends from claim 14, and is therefore allowable for at least the same reasons as claim 14. Claim 29 relates to a data transmission system and includes subject matter analogous to that discussed above in support of the patentability of claim 14, so that claim 29 and its dependent claims 30 to 32 are therefore allowable for at least essentially the same reasons as claim 14.

VI. Conclusion

In view of the above, it is respectfully submitted that all of the presently pending claims 14 to 32 are allowable. It is therefore respectfully requested that the rejections and any objections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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